



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE WA 98104

COPY MAILED

AUG 05 2004

OFFICE OF PETITIONS

In re Application of :
Gary W. Tripp :
Application No. 10/688,361 :
Filed: October 17, 2003 : DECISION ON PETITION
Attorney Docket No. ARCE-1-1008 :
Title: PEER-TO-PEER AUTOMATED :
ANONYMOUS ASYNCHRONOUS FILE :
SHARING :

This is a decision on the petition filed May 24, 2004.

On October 17, 2003, the above-identified application was deposited. On January 26, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Incomplete Nonprovisional Application- Filing Date Not Granted (notice)", advising applicant that the application appeared to have been deposited without at least one claim. The notice further indicated that Figures 46 and 47 appeared to be missing.

On May 24, 2004, Petitioner submitted the instant petition, along with an amendment which deletes references to figures 46 and 47, one claim, and a two-month extension to time to make timely this response.

Petitioner has further set forth that claims 1-7 were constructively present on filing via an incorporation by reference. A review of the Utility Patent Application Transmittal sheet in the electronic file has shown that the instant application is a continuation application, and that the parent application was incorporated by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identifies this application as a continuation of prior application No. 09/910,460, and specifically incorporated by reference the disclosure of the prior application.

Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

(Emphasis added).

If petitioner desires for the examiner to enter claims 1-7 of the parent application, then Petitioner may submit these claims via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application. It is noted that Petitioner has submitted one claim with this petition. Unfortunately, Petitioner has submitted neither claims 1-6, nor an amendment which directs the entry of claims 1-7.

For these reasons, the petition is dismissed.

Claim 7, submitted with the instant petition, will not be entered. Should petitioner wish for claims 1-7 of the parent to be entered, an amendment must be filed.

The original application papers will include only those application papers present on the date of deposit.

¹ See MPEP 608.02(a).

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 17, 2003, using only the application papers filed on that date.

After the mailing of this decision, the application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office